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Brian J. Roberts

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EXAMINER

CHERUBIN, YVESTTE GILBERTE

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/828,643	Applicant(s) ROBERTS, BRIAN J.	
	Examiner Yveste G. Cherubin	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the Amendment filed March 19, 2004.

Claims

2. Claims 1, 10, 12, 18 recite the "first lottery". The Examiner would like to know what the Applicant encompasses by the *first lottery*. It has been assumed for the purposes of this action that "first lottery" was intended to mean the lottery game being played before the first jackpot is won. Clarification is required.

Specification

3. The rejection of 35 USC 112, first paragraph to claims 15-16 has been withdrawn. However, as recited in MPEP 608.01 (I), "Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and *requirement made to amend the drawing and description to show this subject matter*. Accordingly, the Examiner is urging the Applicant to amend the specification and the claim to include the omitted subject matter. No new matter should be entered. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. a. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 26-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 26 recites "pull-tab lottery". There is no support for this limitation in the specification.

Claim 27 recites "future draw lottery". There is no support for this limitation in the specification.

In the event the Applicant disagrees with the Examiner's assumption, the Examiner is urging the Applicant to point to the passage where one can find support for the above cited limitations.

b. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 17 recites the limitation "identification information" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 36 is rejected under 35 U.S.C. 102(e) as being anticipated by Gerow (US Patent No. 5,944,606).

Regarding claim 36, in respect to Fig 7, Gerow discloses a gaming system (100) comprising game ticket (10, 10') for the play of a jackpot game together with a separate ticket-based lottery game, which comprises an indicia for use in the play of a lottery game, and a machine-readable ticket identifier (22') for use in the play of a progressive jackpot game, 4:49-51.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 10-11, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerow in view of Koza (US Patent No. 5,112,050).

Regarding claim 1, Gerow discloses a gaming system (100), comprising a plurality of game tickets in the form of pull-tab cards, see abstract, lines 2-3, 5:5-6, each having indicia (see Fig 4a, 4b) for use in the play of a first lottery game and each also having a respective machine readable ticket code unique (22, 22'), 3:35-37 to that ticket in said system, 4:49-51, the machine readable ticket code for use in the play of a jackpot game, a plurality of gaming ticket dispensers or distributed terminals, as shown in Fig 6, 6:3-5, 7:19-32, a central computer (120) in communication with said terminals, 5:28-29, 7:19-20, each of said terminals having at least a code reader associated with each of said dispensers for reading machine readable ticket code from each ticket dispensed from each dispenser, 2:1-6, 6:7, 6:31-37. Gerow fails to disclose data storage means for storing a prize code, and comparison means for comparing said prize code with said machine readable ticket code from each of said game tickets, and for indicating a match between said machine readable ticket code and said prize code. Koza teaches a lottery system comprising a memory (15) for holding coded value, 4:50-62. Koza further teaches a comparator for comparing coded value to indicate (16) a match condition,

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4:50-62. Upon a matching condition, Koza discloses using audio/visual alarm to provide the indication, 4:50-62. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the matching teaching as taught by Koza into the Gerow type system in order to ensure the security of the system.

Regarding claim 3, with the advancement of the computer technology, one of ordinary skill in the art would have been motivated to have each of said terminals connected on-line with said central computer in order to allow a wide variety of players to take advantage of the gaming system at remote locations.

Regarding claim 4, Gerow teaches providing cards with serrated flaps, which can be lifted to reveal underlying indicia of the value of the card, 3:24-27, 4:37-49.

Regarding claim 5, Gerow discloses each dispensing unit comprising a display and communication means communicating ticket sales information to a control system and wherein said control system being programmed to add a predetermined increment to the amount of a jackpot prize until a match indication is given by the comparing means, said communication means being adapted for communicating said amount of said jackpot prize to said display means, 2:37-57, 6:47-51, 6:63-65, 7:16-18, 42-58.

Regarding claim 6, Gerow teaches that the dispensing unit could read or scan the card as it was dispensed thereby ensuring detection of the jackpot card, 7:15-18 and that the game could be stopped as soon as the jackpot card is dispensed, 6:63-65. Further below, in 7:8-10, Gerow teaches that the jackpot could be restarted after each jackpot card is redeemed and each new game being set with an initial predetermined jackpot value (which could be \$0 or 500), 7:8-11, 43-59.

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Regarding claims 10-11, 37 they recite the limitations of claim 1 with the exception of the independent subsystems. Burr is cited to teach a very large number of remote units being employed in state-wide or nation-wide or city-wide lottery system where each state or city would have their own central unit, being read as subsystem, which in turn would be communicating with one central/supervisory computer unit, 3:1-17, 4:53-65.

Claims 2, 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerow in view of Koza as applied above, and further in view of Burr.

Regarding claim 2, Gerow in view of Koza disclose the claimed invention as substantially as explained above. Gerow in view of Koza fail to disclose storage means and a modem intermittently uploading and downloading information. Burr teaches a system and method for distributing lottery tickets including a large number of remote ticket-dispensing units connected to a central computer, see abstract and Fig 1. Burr further teaches the remote ticket-dispensing units being connected intermittently via modem as shown in Fig 1, e.g. once each day or week to said central computer, see abstract, 3:1-17, 5:5-28. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the communication feature as taught by Burr into the Gerow in view of Koza type system in order to keep data updated and therefore ensure the accuracy of the system.

Regarding claims 8-9, Burr teaches tickets being printed at time of dispensing, 15:54-61.

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Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerow in view of Koza as applied above, and further in view of Weingardt.

Regarding claim 7, Gerow discloses the capability of having more than one jackpot, 7:9-11. However, Gerow in view of Koza fail to disclose a predetermined increment to a second monetary pool in response to ticket sales information. Weingardt teaches a gaming system using a progressive jackpot to award players. Weingardt further teaches providing funding of future pools by setting aside into future pools portions of wagers made by current players, see abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the seeding/shadow in relation to the second prize pool teaching as taught by Weingardt into the Gerow in view of Koza type system in order to provide an attractive pool amount at the time of the second jackpot.

a. Claims 12-14, 19-26, 29-32, 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerow (US Patent No. 5,944,606) in view of Haste, III (US Patent No. 5,580,311).

Regarding claims 12, 23, 32, Gerow discloses storing a plurality of gaming tickets, see abstract, lines 2-3, 5:5-6 in each of a plurality of gaming ticket dispensers as shown in Fig 6, 6:3-5, 7:19-32, providing a code reader associated with each of said dispensers for reading machine readable ticket code from each ticket dispensed from each dispenser, 2:1-6, 6:7, 6:31-37, detecting said machine readable ticket code on the ticket indicating that the ticket is a winner of the jackpot game, 6:5-11, 7:16-18. Gerow fails to

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disclose informing the recipient of the ticket, upon dispensing said ticket, that the ticket is a winner. Haste teaches a dispensing unit capable of dispensing lottery tickets, which are uniquely coded, see abstract, 2:56-58. Haste further teaches a bar code reader reading the machine-readable ticket code as the ticket is being dispensed. In addition, Haste teaches informing the recipient of a ticket that the ticket is a winner upon dispensing it, 5:14-28. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the above cited feature as taught by Haste into the Gerow type system in order to heighten players' excitement.

Regarding claim 13, Gerow discloses accumulating a first prize pool by detecting each ticket dispensed from said dispensers and adding a corresponding amount to said first prize pool, 2:41-43, 5:55-56, 6:47-51, 7:42-52. Gerow further discloses stopping the game as soon as the jackpot card is dispensed, 6:62-64. With this step, it's obvious that the accumulation of the jackpot is stopped upon the detection of the dispensing of the winning ticket. Gerow discloses with more than one jackpot ticket present, the accumulation for a new jackpot could be restarted upon the detection of the winning ticket, 7:9-11. Since jackpot accumulation is done when a ticket is dispensed, it would have been obvious that the accumulation of the new prize pool would start upon the detection of the dispensing of an additional ticket after the detection of the winning ticket.

Regarding claim 14, Gerow discloses providing the operator the complete flexibility of selecting the initial value of a jackpot, which can be \$0 or \$500, 7:4-59. Accordingly,

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starting a new prize pool with an amount greater than zero would be an obvious matter of design choice.

Regarding claim 19, Gerow discloses a gaming system and method of dispensing gaming tickets, see abstract. Gerow discloses providing a plurality of ticket dispensing units, see fig 6, 7:19-32, dispensing instant winner lottery tickets from said machines, see abstract, lines 12-14, see Fig 2, each instant winner lottery ticket having information identifying one of a plurality of specific games in which the ticket is issued, see Fig 2, 4a, 4b, and having a removable cover (18) over human-readable gaming information, see Fig 1b, 1c, each of said tickets also bearing machine readable unique identification information (22'), 4:49-51, providing a jackpot prize pool which tickets from the plurality of said specific games are eligible to win, 5:46-67, providing a code reader in each of said dispensing machines for reading said machine readable identification information and producing corresponding signals, 6:31-43. Although Gerow discloses detecting the signals corresponding to the jackpot, 7:16-18 Gerow fails to identify a winner of said jackpot. Haste teaches identifying the winner of the jackpot card, 5:14-28. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the above cited feature as taught by Haste into the Gerow type system in order to heighten players' excitement.

Regarding claim 20, it recites the limitations of claim 13, therefore refer to the rejection of claim 13 above for rejection.

Regarding claim 21, it recites the limitations of claims 15-17, therefore refer to the rejection of claim 15-17 above for the rejection.

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As per claim 22, Haste teaches informing the recipient of the winning ticket that the ticket is the winner upon dispensing, 5:14-28.

Regarding claims 24-26, Gerow teaches providing cards with serrated flaps that can be lifted to reveal underlying indicia of the value of the card, 3:24-27, 4:37-49. In addition, Gerow is cited to teach using tickets in the form of scratch off, see Fig 2, and pull-tab, see Figs 4a, 4b.

Regarding claim 29, Gerow discloses whether the game ticket wins the jackpot being determined by a predetermined selection of a winning machine-readable ticket identifier, 4:7-22.

Regarding claim 30, Gerow discloses his jackpot gaming system of a progressive nature, 4:2-6.

Regarding claim 31, Gerow discloses incrementing the prize amount in response to the lottery ticket dispensing machine dispensing a game ticket, 4:2-7, 5:55-56, 6:47-50

Regarding claim 34, refer to the rejection of claim 13 for rejection.

Regarding claim 35, Gerow discloses displaying the jackpot prize amount (130), 5:45-47, 6:23-25, 47-49, Fig 6.

Claims 15-18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerow in view of Haste, III and further in view of Weingardt (of record).

Regarding claims 15-16, Gerow discloses the claimed invention as substantially as explained above. Gerow further discloses the capability of having a plurality of jackpot prizes. However, Gerow in view of Haste III fail to disclose accumulating a second prize

pool by adding an amount of money per ticket significantly less than the amount added to the first prize pool for each ticket dispensed prior to the award of the jackpot prize and using said second prize pool to start the new prize pool after the detection of the winning ticket. Weingardt teaches a gaming system using a progressive jackpot to award players. Weingardt further teaches providing funding of future pools by setting aside into future pools portions of wagers made by current players, see abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the seeding/shadow in relation to the second prize pool teaching as taught by Weingardt into the Gerow in view of Haste III type system in order to provide an attractive initial value of the new (second) prize pool and therefore avoiding to have a \$0 initial value which would not attract players. As for the setting of the amount, Gerow discloses allowing the operator to select an increment percentage for the sale of each ticket, 7:42-58. Therefore, setting the amount significantly less than the amount added to the first prize pool for each ticket dispensed would have been an obvious matter of design choice.

Regarding claim 17, portions of claims 15-16 are recited, therefore refer to claims 15-16 for the rejection. In addition, Weingardt is cited to teach storing the identification information and the winner-indicating information in an information storage means, 5:20-24.

Regarding claim 18, Gerow teaches providing cards with serrated flaps that can be lifted to reveal underlying indicia of the value of the card, 3:24-27, 4:37-49.

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Claims 27-28, 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerow in view of Haste III as applied above, and further in view of Koza.

Regarding claim 33, Gerow in view of Haste III disclose the claimed invention as substantially as explained above. Gerow in view of Haste III fail to disclose comparing the machine-readable ticket identifier from the game ticket with a stored jackpot winning ticket identifier. Koza teaches a comparator for comparing coded value to indicate (16) a match condition, 4:50-62. Upon a matching condition, Koza discloses using audio/visual alarm to provide the indication, 4:50-62. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the matching teaching as taught by Koza into the Gerow in view of Haste III type system in order to ensure the security of the system.

Regarding claim 27, Koza '050 teaches a lottery gaming system wherein the game ticket is a future draw lottery ticket having indicia, which are matched against a future drawing event to determine if the lottery ticket is a winner, 7:25-41.66. Regarding claim 28, Koza '050 teaches whether the game ticket that wins the jackpot is determined randomly at the time the game ticket is dispensed, 6:24-25.

Response to Arguments

7. Applicant's arguments filed March 19, 2004 have been fully considered but they are not persuasive. Applicants assert that none of the references meet the claimed limitation "a plurality of game tickets each having indicia for use in the play of a first lottery game" The Examiner notices that the Applicant argues limitations that

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were not previously recited. The claims have been examined to reject this added limitations, therefore the arguments are moot. In response to arguments that the references to Haste and Burr cannot be combined, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one verses in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969). In this case, all the cited references are within the field of the inventor's endeavor, therefore the combination is proper. As per claim 3, it's known that the world is turning into electronics and online communications are being used for various reasons such as reaching remote users/players/customers, lowering the price for long distance communications, etc..... The Examiner are content that the cited references meet the claimed limitations, therefore the rejection stands.

Prior Arts

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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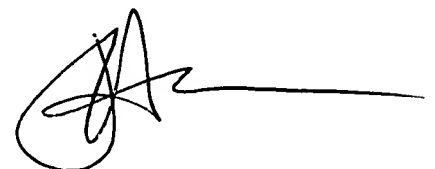
- a. US Patent No. 5,282,620 to Keesee, which teaches lottery game and method of playing a lottery game.
- b. US Patent No. 5,286,023 to Wood, which teaches video lottery game.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

ygc



**JESSICA HARRISON
PRIMARY EXAMINER**